



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

0 2 AUG 1990

Group 210
Art Unit 212
dli

Paper No. 71

In re application of

Ole K. Nilssen :
Serial Number: 06/787,692 :
Filed: October 15, 1985 : **DECISION ON PETITION**
For: INVERTER WITH RESONANT :
L-C CIRCUIT :

This letter is responsive to the petition filed March 1, 1990 requesting that the Commissioner:

1. reverse the Examiner's holding of abandonment of the subject application;
2. reverse the Examiner's refusal to enter new claims 145 and 146; and
3. remove the examiner from this, as well as several other applications, reassigning those applications to another examiner.

In response to Petitioner's request to withdraw the holding of abandonment, it is noted that the response dated January 25, 1990, included no explanation of how the claims are patentably distinguished from the Walker reference. Thus, the amendment was not responsive to the Board of Appeals decision (note MPEP 1214.01). Accordingly, the examiner should have written an Action, incorporating the rejection suggested by the Board of Appeals into that Action, and made the Action FINAL. This was not done. Accordingly, the application is being returned to the examiner for withdrawal of the holding of abandonment and the entry of the appropriate Action. The only matters to be considered by the examiner are those not affirmed by the Board of Appeals. Thus, the only claims open to the possibility of further prosecution are claims 139 to 142. The petition as to this matter is **GRANTED**.

In response to Petitioner's second request, MPEP 1214.01 clearly states that on a remand from the Board of Appeals to the examiner under 37 CFR 196(d), the considerations are limited to the issues of the suggested rejection. Petitioner's substitution of claims 145 and 146 for claims 143 and 144, respectively, which latter claims were not included in the 37 CFR 196(d) rejection, is not a permissible response to the suggestion of rejection by the Board of Appeals. Thus, the examiner's refusal to consider claims 145 and 146 was proper. The petition as to this matter is DENIED.

In response to Petitioner's third request, an application will not be reassigned to another examiner at the request of the applicant except under the most extreme circumstances of compelling reasons, such as a conflict of interest. Furthermore, the Patent and Trademark Office assigns examiners to an art area based on the examiners' professional experience, and educational and technical training. In the present situation, Senior Examiner Beha has been examining in the electrical converter and inverter art for many years. His extensive education and experience coupled with an extraordinarily distinguished record clearly qualify him to examine the present application. Petition to reassign this application is DENIED.

SUMMARY

Petition to reverse the holding of abandonment is GRANTED.

Petition to reverse the refusal to enter claims 145 and 146 is DENIED.

Petition to replace the examiner is DENIED.



Donald G. Kelly, Director
Patent Examining Group 210
Industrial Electronics,
Physics and Related Elements

Ole K. Nilssen
Caesar Drive, RR-5
Barrington, Illinois 60010